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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,353

Applicant(s)

ROYSTON, TYMARSHALL, E.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

On page 8, line 12, the word "maid" should be "made".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said personal identification number" in line 11.

There is insufficient antecedent basis for this limitation in the claim. The Examiner believes that the Applicant is referring to the "alphanumeric identification code" in lines 2-3 of the claim and will consider the claim in this light.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski (5,905,246).

Claims 1, 8, and 13: Fajkowski discloses a system and method for redeeming consumer-selected electronic coupons comprising:

- a. storing consumer-selected coupon data on a portable coupon card (col 5, lines 27-30);
- b. scanning a bar code associated with a product selected for purchase by the consumer (col 4, lines 24-32 and col 17, lines 7-27);
- c. scanning the portable coupon card to read the stored coupon data (col 4, lines 24-32); and
- d. reducing the price of the product based upon the coupon data stored on the portable coupon card (col 4, lines 47-49).

Claim 2: Fajkowski discloses a method for redeeming consumer-selected electronic coupons as in Claim 1 above, and further discloses selecting the coupons from an on-line library of available coupons (col 29, lines 42-61).

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Claims 3 and 11: Fajkowski discloses a system and method for redeeming consumer-selected coupons as in Claims 1 and 8 above, and further discloses reducing the price of the product if the coupon data is valid, i.e. not past the expiration date or maximum number of uses (col 4, lines 24-49).

Claim 4: Fajkowski discloses a method for redeeming consumer-selected coupons as in Claim 1 above, and further discloses receiving the portable coupon card from a vending machine (possibly located in the vicinity of the POS system) (col 6, lines 1-10).

Claim 6: Fajkowski discloses a method for redeeming consumer-selected coupons as in Claim 1 above, and further discloses selecting the coupons over a computer network connecting a host and remote computer (col 6, lines 20-43).

Claim 7: Fajkowski discloses a method for redeeming consumer-selected coupons as in Claim 1 above, and further discloses the consumer paying for the portable coupon card (col 27, lines 30-41).

Claim 9: Fajkowski discloses a system for redeeming consumer-selected coupons as in Claim 8 above, and further discloses transmitting the coupon redemption information from the redeeming vendor to the host computer (issuer) (col 4, line 64 – col 5, line 19).

Claim 10: Fajkowski discloses a system for redeeming consumer-selected coupons as in Claim 8 above, and further discloses registering the consumer to establish a new account (col 8, lines 55-62) and selecting the coupons from an on-line library of available coupons (col 29, lines 42-61).

6. Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (5,865,470).

Claim 14: Thompson discloses a transaction instrument, comprising:

- a. a rectangular card having a plurality of product identifiers representing coupons imprinted on a first side (col 3, lines 18-31 and col 8, lines 1-2); and
- b. a magnetic strip on a second side of the card for storing data representing the coupons (col 3, lines 18-31).

Claim 15: Thompson discloses a transaction instrument as in Claim 14 above, and further discloses that the product identifiers include the name of the company, product or brand name, and a quantity indicator (Figure 24).

Claim 16: Thompson discloses a transaction instrument as in Claim 14 above, and further discloses that the stored data includes the expiration date and quantity indicator (i.e. number of times the coupon may be redeemed)(col 13, lines 8-13).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (5,865,470) in view of Christensen (6,035,280).

Claim 5: Fajkowski discloses a method for redeeming consumer-selected coupons as in Claim 1 above, but does not explicitly disclose that the portable coupon card is delivered to the consumer by mail. However, Christensen discloses a similar method of redeeming coupons using a portable coupon card which is delivered to the consumer through the mail (col 6, lines 19-21 and col 7, lines 62-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to deliver the portable coupon card in Fajkowski in various ways to include the postal mail system. One would have been motivated to use mail to deliver the portable coupon card to the consumer in order to allow participation by consumers who are not in the vicinity of Fajkowski's card dispensing machine, such as consumers accessing the system via the Internet.

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9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (5,865,470) in view of Fajkowski (5,905,246).

Claim 17: Thompson discloses a transaction instrument as in Claim 14 above, but does not explicitly disclose that the portable coupon card is dispensed by a vending machine after receiving payment from the consumer. However, Fajkowski discloses a similar transaction instrument (portable coupon card) which is delivered (sold) to the consumer via a vending machine (col 6, lines 1-10 and col 27, lines 30-41). Therefore, it would have been obvious to one having ordinary skill in the art when the invention was made to utilize a vending machine, such as an ATM, to deliver the transaction instrument in Thompson, and to charge the consumer a fee for the card. One would have been motivated to sell the cards through vending machines in order to expand the convenience and availability of the cards to a wider range of consumers, i.e. vending machines are usually available for use 24 hours a day, 7 days a week. Furthermore, by charging a fee for the card would help dissuade consumers from obtaining a plurality of portable coupon cards and then not utilizing the coupons thereon, i.e. consumers would desire to "get their money back" by purchasing the products on the coupons at the discounted price.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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a. Kitsukawa et al (6,282,713) discloses a system and method for providing online advertising (and coupons) which displays a plurality of available coupons for products, allows the consumer to select one or more of the coupons, and stores the selected coupons on a removable medium (portable coupon card).

b. Ukai et al(US 2002/0077907) discloses a system and method for storing consumer-selected coupons on an IC card.

c. Kernahan (US 2002/0128903) discloses a system and method for providing coupons to consumers over the Internet which may be downloaded and saved on a portable consumer device, such as a PDA.

d. Thakur et al (US 2002/0194069) discloses a system and method for using a magnetic strip card to provide coupons and discounts to consumers.

e. Jaalinoja et al (US 2003/0014315) discloses a system and method for providing and storing product information to include coupons on a consumer's cellular telephone (portable coupon device).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
June 10, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622